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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,945	06/26/2001	Martin Bondo Jorgensen	0459-0569P	1016
30593	7590	08/22/2006		EXAMINER
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195			DABNEY, PHYLESHA LARVINIA	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/787,945	JORGENSEN, MARTIN BONDO	
	Examiner	Art Unit	
	Phylesha L. Dabney	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 5/23/06.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,14-16 and 18 is/are rejected.
- 7) Claim(s) 3-13 and 15 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 6/26/01 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

This action is in response to the amendment received on 02 November 2005 in which claims 1-18 are pending.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "*microphone/telecoil controlled by the controlling means*" of claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant states that the control means is adapted to control a claimed element (page 8, arguments dated 5/23/06); however the claims are written in such a manner that the controlling means can control either a telecoil or microphone operation. It is not clearly understood how the user's finger is being used to control the telecoil or microphone since these two components have distinct configurations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito (U.S. Patent No. 5,708,725).

Regarding claim 1, Ito teaches a hearing device (figs. 1-6) which reads on a hearing aid comprising: a housing (figs. 1-6) and means (7-8, 11-12, 14-15) for controlling an operation mode of the hearing aid (which reads on the spring biasing force, col. 5 lines 51-54, for pressing the headset to the ears to prevent slippage in conjunction with the retraction force of the spring

coils, 15, in the headband arms, col. 5 lines 56-65, used to maintain an on-state of the headset and switches to off when no force is applied), wherein said controlling means (20a) are adapted to be responsive to a force (spring biasing force, col. 5 lines 51-55) applied by a user's finger to a part of the user's auricle of an ear of a hearing aid user.

Regarding claim 14, Ito teaches a hearing aid according to claim 1, wherein the controlling (20a) are adapted to control a power on/off operation mode of the hearing aid (col. 4 lines 38-46).

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Van Vroenhoven (U.S. Patent No. 5,295,191).

Regarding claim 18, Van Vroenhoven teaches a hearing aid (figs. 1-2) adapted to be positioned within an ear canal of an ear of a user, the hearing aid comprising a housing (4) and means (12-14, 19-20) for manually removing the hearing aid from the canal, the removing means being fastened to the hearing aid and extending from the hearing aid toward an auricle of the ear (which reads on the hearing aid being placed deep within the ear canal and hidden from view, col. 2 lines 10-13, and the removing means extending outward therefrom to the outer ear/auricle), wherein the removing means comprise a stiff member (12-13, col. 3 lines 31-34) adapted to remain in essentially the same predetermined position at least during normal deflection of the stiff member relative to the housing since the stiff member is rigid, it will remain in the same position when a deflection force is applied/impinging.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 5,708,725).**

Regarding claim 2, Ito '725 teaches a hearing aid according to claim 1, the housing (4-8), wherein the controlling means (7-8, 11-12, 14-15 since these elements are used in conjunction to control switch 20) comprise sensing means (20, 21) positioned on at least one side of the housing facing the head (this is shown in fig. 2 relative to fig. 4 where it is shown that protrusion 21 is located at the innerside of arm 7 and the switch 20 rests at the back of a ledge at the innerside of arm 7) or facing the ear lobe of the user, the sensing means being adapted to sense a force (spring biasing force, col. 5 lines 51-55) applied to the user's auricle, and the controlling means being responsive to the sensing of the sensing means (which reads on the spring biasing force, col. 5 lines 51-54, for pressing the headset to the ears to prevent slippage in conjunction with the retraction force of the spring coils, 15, in the headband arms, col. 5 lines 56-65, used to maintain an on-state of the headset and switches to off when no force is applied). Ito '725 does not teach the housing is adapted to be placed at a position behind the ear. However, it is known in the art to alternatively position hearing aid housings (4-8) at a different location, such as at the back of the head for preventing interference with other articles, such as hats, barrettes, etc., that may be on the head. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to position the hearing aid housing of Ito at an alternate location for the reason stated above.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 5,708,725).

Regarding claim 17, Ito teaches that the controlling means comprises circuitry (7-8, 11-12, 14-15, applies tensioning force; circuitry col. 4 line 47 through col. 5 line 18). Ito does not specifically teach that the circuitry comprises an integrated circuit. However, it is well-known to use integrated circuitry in devices, such as hearing aids, to control their function because of their small size, reliability and fast switching, and low power consumption. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an integrated circuitry in the invention of Ito for the reasons stated above.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 5,708,725) in view of Schmidt et al (U.S. Patent No. 6775390).

Regarding claim 16, Ito teaches a hearing aid according to claim 1, wherein the controlling means (20a) are adapted to control the mode of the hearing aid since the control means switches the hearing aid on/off by interrupting the power supply from the battery (col. 5 lines 56-65 and col. 7 lines 15-31). Ito does not teach the hearing aid comprises a microphone. Schmidt teaches including a microphone (enclosed in shell 82, col. 3 line 25) in a hearing aid attached to the hearing aid arm (Schmidt, 70; which corresponds to the arm of Ito, 7) to beneficially allow the hearing to be used as a telephonic communication device. Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to include a microphone with the hearing aid in the invention of Ito as taught by Schmidt for the reason stated above.

Allowable Subject Matter

6. Claims 3-13 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive.

With respect to the Applicant's arguments pertaining to the drawing objections. The Examiner is maintaining the drawing objection for the claims containing limitations pertaining the microphone and telecoil, since they are structural not the same. And, the 35 U.S.C. 112 2nd rejection above is pertaining to the Applicant's arguments contained on page 8 of the amendment dated 23 May 2006.

With respect to the Applicant's arguments pertaining to claims 1 and 14 that Ito does not teach "*the controlling means being adapted to be responsive to a force applied by a hearing aid user's finger to a part of the user's auricle,*" the Examiner disagrees. Indirectly, at least when the hearing device is being removed from the user's ear, the user grasps the hearing device using his fingers and thus a negative (opposite) force is applied to the user's ear. Because of this

negative force and the nature of the hearing device (discussion above in the rejection) the controlling means has an on/off function relative to this force.

With respect to the Applicant's arguments pertaining to claim 18 that Van Vroenhoven does not teach a stiff member adapted to remain in essentially the same predetermined position at least during normal deflection of the stiff member relative to the housing, the Examiner disagrees. As previously stated, Van Vroenhoven teaches the stiff member being rigid relative to the housing, thus it will remain in the same position during normal deflection. Furthermore, in light of the Applicant's arguments, the Examiner believes that there is a misplaced modifier and in such case, the Van Vroenhoven references clearly applies to the claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ito (U.S. Patent No. 6,542,615) teaches placing the hearing aid at a location behind the head (figures 1-10).

Sacherman et al (U.S. Patent No. 5,369,857) teaches the ability to rotate the hearing aid in all directions (col. 2 37-40).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L. Dabney whose telephone number is 571-272-7494. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P O Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 273-8300, for formal communications intended for entry and for informal or draft communications, please label "Proposed" or "Draft" when submitting an informal amendment.

Hand-delivered responses should be brought to:

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Randolph Building
401 Dulany Street
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August 8, 2006


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